The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN R. DODGE,
GRANT BYERS, and JEFF MARX

Appeal No. 2004-1848
Application No. 09/990,054

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Dean R. Dodge et al. appeal from the final rejection of claims 1 through 6, all of the claims pending in the application. Before considering the appeal on its merits, we find it necessary to remand the application to the examiner under the authority of 37 CFR § 41.50(a)(1) and MPEP § 1211 to resolve the following matters.

In the final rejection (Paper No. 7), the examiner rejected claims 1 through 6 under 35 U.S.C. § 103(a), claim 6 under 35

U.S.C. § 112, first paragraph, claims 1 through 3 under 35 U.S.C. § 112, second paragraph, and claims 1 through 6 provisionally under the judicially created doctrine of obviousness-type double patenting. Of concern are the 35 U.S.C. § 112 and double patenting rejections.

The record shows that the appellants filed a paper (Paper No. 10) subsequent to final rejection proposing amendments to claims 1 and 6 which directly addressed, and altered, the claim language that prompted the 35 U.S.C. § 112 rejections. The examiner stated in an advisory action (Paper No. 12) that the amendments would be entered for purposes of appeal and that "[w]ith regards to the 112 first rejection, Examiner notes that the amendments overcome the rejection, but notes that the same problem exists at the end of claim 4." The examiner at this point made no mention of the 35 U.S.C. § 112, second paragraph, rejection, even though the antecedent problem forming the basis for the rejection had been eliminated by the amendment. In their main brief (Paper No. 13), the appellants did not argue the 35 U.S.C. § 112 rejections on the assumption that each had been obviated by the amendments. The examiner, however, restated these rejections in the answer (Paper No. 14) and the appellants then argued same in a reply brief (Paper No. 15).

On remand, the examiner is directed to reevaluate the standing 35 U.S.C. § 112, first paragraph, rejection of claim 6 and the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 3 in light of the amendments subsequent to final rejection and, if these rejections are maintained on appeal, to explain why these claims, which no longer contain the language viewed as problematic by the examiner, continue to be so rejected. The examiner also is directed to reassess the statement in the advisory action suggesting that claim 4 should be rejected under 35 U.S.C. § 112, first paragraph, and to take appropriate action consistent with this reassessment.

The record also shows that the double patenting rejections set forth in the final rejection and answer are based on Application No. 09/552,125, filed April 19, 2000. As this application has since matured into U.S. Patent No. 6,672,436 to Keil et al. (Keil), the double patenting rejections no longer are provisional in nature. The problem here is that the claims in the patent (claims 1 through 3) ostensibly do not correspond to the claims in the application (claims 1, 2, 3, 8, 9 and 14) upon which the provisional rejections were founded.

On remand, the examiner is directed to reconsider the double patenting rejections in light of Keil's patent claims 1 through 3

and, if the rejections are maintained on appeal, to explain the rejection of each claim in terms of the differences between the claim and the respective patent claim(s) with which it is being compared.

The application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01, item (D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMANDED

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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) BOARD OF PATENT
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CHARLES E. FRANKFORT)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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JOHN P. MCQUADE)
Administrative Patent Judge)

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HARNESS, DICKEY & PIERCE, P.L.C.
P. O. BOX 828
BLOOMFIELD HILLS, MI 48303